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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,212	07/28/2003	James Jannard	NOCODE2.005C2	5469
20995	7590	08/10/2004	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				MAI, HUY KIM
		ART UNIT		PAPER NUMBER
		2873		

DATE MAILED: 08/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/628,212	JANNARD ET AL.
	Examiner Huy K. Mai	Art Unit 2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 28 July 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-12 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 28 July 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/18/03 & 4/26/04</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Information Disclosure Statement

1. The Information Disclosure Statements filed on Jul. 28, 2003 and April 26, 2004 are acknowledged.

Oath/Declaration

2. The declaration filed on April 26, 2004 is acceptable.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 3, 8 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Spitzer (6,349,001).

The limitations in claims 1,3,8,9 are shown in Pitzer's Fig. 1, 11, column 7, lines 28-67. Pitzer discloses an eyeglass frame 100, comprising: a support for supporting at least one lens in the path of a wearer's field of view; a first ear stem attached to the support, for extending in a posterior direction along a first side of the wearer's head; a second ear stem attached to the support, for extending in a posterior direction along a second side of the wearer's head; at least one microphone 106 disposed in at least one of the support, first ear stem, and second ear stem, the microphone 106 being arranged to face towards a head of a wearer of the eyeglass frame;

and a transceiver 810 supported by at least one of the support, the first ear stem, and the second ear stem, the transceiver being configured to wirelessly transmit a digital signal representative of an output of the microphone.

Regarding claim 8, Pitzer discloses in column 8, lines 1-4, the microphone may be placed at the bottom of the eyeglass frame.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pitzer.

The limitations in claims 10-12 are shown in Pitzer's Figs. 1,11 as discussed above, except for the wind sock disposed over the microphone. The Pitzer's eyeglasses including a microphone is used outdoor will be effect by the wind.

It was commonly known to those ordinary skill in the art that a wind sock disposed over a microphone for the purpose of reducing the effect of wind noise on the microphone.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the microphone in the Pitzer's eyeglass frame by forming a wind sock as common knowledge for the purpose recognized in the art of Pitzer, as discussed above.

7. Claims 2,5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pitzer.

Pitzer discloses the claimed invention wherein the microphone may be mounted within the eyeglass frame including within the nosepiece to sense the vibration produced by the user's speech instead of positioned to face upwardly to toward, horizontally toward, or downwardly toward a head of a wearer as claimed by applicant. Although Pitzer does not discuss positioning the locations of the microphone face toward to the head of a wearer, such these claimed locations of the microphone are still within the scope of mounting the microphone within the eyeglass frame for sensing the vibration produced by the user's speech. It would have been obvious to one of ordinary skill to modify the Pitzer's device by locating the microphone to face upwardly to toward, horizontally toward, or downwardly toward a head of a wearer for perform the same function of sensing the vibration produced by the user's speech as the applicant does. Such a modification of the location of the microphone would not change the scope of the invention in the Pitzer's device. See *In re Kuhte*, 168 USPQ 7 (CCPA 1975), and *In re Japik*, 86 USPQ 70 (CCPA 1950) (Changing location of the microphone relative to the head of a wearer has no novel or unexpected result).

Regarding claim 4, Pitzer discloses the claimed invention wherein the transceiver for transferring the signal from the microphone and communicating with another device except for transferring a readable signal no more than about twenty yards. Since one type of transceiver has transmitting properties appropriate to a particular industrial use than another type of transceiver, it would have been obvious to a worker having general skill in this art to select a known transceiver on the basis of its suitability for intended used as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Art Unit: 2873

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Mai whose telephone number is (571) 272-2334. The examiner can normally be reached on M-F (8:00 a.m.-4:30 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached on (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1562.



Huy Mai
Primary Examiner
Art Unit 2873

HKM/
August 6, 2004